



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,794	09/11/2003	Dario Sansone	08350.1767-00000	4545
58982 7590 12/16/2009 CATERPILLAR/FINNEGAN, HENDERSON, L.L.P. 901 New York Avenue, NW WASHINGTON, DC 20001-4413				
EXAMINER				
HURLEY, KEVIN				
ART UNIT		PAPER NUMBER		
3611				
MAIL DATE		DELIVERY MODE		
12/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,794

Applicant(s)

SANSONE ET AL.

Examiner

KEVIN HURLEY

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 71-74, 76, 87, 115, 116, 118 and 122-146 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 71 and 118 is/are allowed.
- 6) ☒ Claim(s) 72-74, 76, 87 and 122-146 is/are rejected.
- 7) ☒ Claim(s) 115 and 116 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Protest

1. A third party protest was filed Protest Under 37 CFR 1.291 on 28 August 2009. A certificate of service appears on page 7 of the protest.

2. The protest argues that claims 122-146 as newly presented by Applicant in the Reply to Office Action dated August 7, 2009 are not patentable because they recapture subject matter surrendered during prosecution of U.S. Patent No. 6,286,615 ("615 Patent"), and they are not "narrowed" (materially or otherwise) with regards to any "overlooked" aspect of the invention.

The examiner agrees with this position. The newly amended claims effectively remove structure from the original claims, i.e. the structure which steers both of the rollable rear supports. This has the effect of broadening the reissue claims as compared to the patent claims. The examiner also agrees that this issued was not an overlooked aspect of the invention, since the issue of steering the rollable rear supports was an express subject of the arguments made during prosecution of the original patent.

3. The protest also argues claims 115 and 116 are not patentable because they are improper dependent claims that delete elements required by their parent claims.

The examiner agrees with this position as well. It appears that claims 115 and 116 attempt to swap out structure, rather than further limit the parent claim.

Claim Objections

4. Claims 115 and 116 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 115 recites that "only one of the rear supports is configured to be rotatable about the rear vertical axis." which thus removes the limitation in claim 1 that the maneuvering system includes an actuator "for rotating said rear supports about the rear vertical axis".

Claim 116 recites "only one of said rear supports is pivotable about the rear vertical axis" which removes the limitation from claim 9 that "said rear supports being pivotable about a rear vertical axis".

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 72-74, 76 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

The claims fail to recite any actual connection between the recited elements such as the third hydraulic actuator, the electronic control unit, and the third position detector.

7. Claim 87 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 87 "the actuator" lacks proper antecedent basis.

Specification

8. The amendment filed 7 August 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows.

Claims 73-74, 123, 139 recite "a second position detector". According to the original patent, there is a "first position detector 33" and a "third position detector 34". There is no second position detector.

Applicant is required to cancel the new matter in the reply to this Office Action.

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The following terms and phrases used in the claims fail to find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Thus it unclear what elements in the specification the claims are referring to:

the "second position detector" recited in claims 73-74, 123, 139

Reissue Applications

10. Claims 122-146 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

11. In the amendment filed 15 May 2001 in the parent application 09/531,565, applicant amended claim 1 to include the following limitations:

said chassis includes a yoke that supports said rear support, and has a vertical pivot journal coupled to revolve on a support plate fixed to an end of a second actuator;

said second actuator comprises a second hydraulic jack set with a vertical axis, which has a second rod with a second rod end fixed to said plate and a second cylinder end, wherein said rod slides, integral with said frame;

the cylinder of said second hydraulic jack is an integral part of said frame being connected thereto by means of a first articulation for moving said chassis with respect to a fixed point on said frame in order to move the rear rotatable support inward of said frame.

12. Furthermore, in the same amendment filed 15 May 2001, applicant argued that claims 12-14 (claims 9-11 of the issued patent) of parent application 09/531,565 were patentable over the prior art:

“because the prior art lacks a steerable machine having a pair of rollable front supports that are rotatable about a front vertical axis and are controlled by power steering. The prior art also lacks a pair of rollable rear supports that are pivotable about a rear vertical axis and are controlled by a steering hydraulic cylinder.”

These limitations were added to overcome a patentability rejection and thus constitute surrendered subject matter. Any claims which do not contain one of these two sets of limitations are thus guilty of recapture.

Allowable Subject Matter

13. Claims 1-11, 71-72, 74, 76, 87, and 118 are allowable over the prior of record.

Response to Arguments

14. Applicant's arguments filed 7 August 2009 have been fully considered but they are not persuasive.

Applicant has argued that the “aspect that only one of the rear supports is steerable is an

overlooked aspect of the invention, in that this aspect is not included in any of the claims of the original patent, and was not included in any claim during the prosecution of the original patent". The examiner disagrees in that the steering of the rear supports was expressly argued for patentability in the parent case. Since the steering of the rollable rear supports was addressed, it would not qualify as an "overlooked aspect" of the invention.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN HURLEY whose telephone number is (571)272-6646. The examiner can normally be reached on Monday-Friday 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin Hurley/
Primary Examiner, Art Unit 3611

December 15, 2009